

II. REMARKS

Claims 2-5 and 7-14 were cancelled without prejudice. Two independent claims 15 and 45 and forty dependent claims 16-44 and 46-57 were added to more clearly define the subject matter of the invention and thereby place all of the claims remaining in the application in condition for allowance. Claim 45 is broader than claim 15. Claims 15-57 are pending in the present application. No new matter was presented and the amendments are deemed unobjectionable. For the convenience of the Examiner, Applicants have provided cites of support to the patent application in an exemplary independent claim, which can be found at the end of this reply and amendment. Applicants assert that all of the newly added claims are similarly supported by the record. The exemplary cites of support are provided to show presence of substantive antecedent basis for the newly worded claims pursuant to 35 USC § 112 and would be improperly construed as narrowing limitations on the scope of the claims. Entry of the amendment is respectfully requested. It is also respectfully requested that the Examiner reconsider the present application and claims as currently pending in view of the following remarks.

A. Interview

Applicants gratefully acknowledge the Examiner interview of June 25, 2004 and appreciate the Examiner's time and consideration. The interview was conducted telephonically at 11:00AM EST and in attendance were Applicants William O. Mattick, Lawrence I. Ranka and their representatives Steven B. Walmsley and Brian L. Ribando. During the interview, a proposed amendment and prior art of record were discussed, particularly the ACEEE reference. In particular, newly added independent claims 15 and 45 were discussed. Applicants pointed out that the new claims were presented to emphasize the

novel and unobvious limitation of sales-weighting of environmental performance values by forecasts of sales of vehicle configurations. The Examiner suggested that he would nonetheless reject the independent claims under 35 USC § 101 because of the absence of earlier-claimed Internet and website limitations. Applicants expressed the need to research the issue before responding. As a basis for a non-obviousness argument, the Applicants explained that at least the primary cited reference is significantly different because it could be used to complement Applicants' invention. The Examiner invited Applicants to present this argument in writing in the amendment. Given the § 101 issue, however, no agreement on patentability was reached and it was discussed that a Rule 1.111 Reply would be filed and the application reconsidered. As required by 37 CFR 1.133, Applicants hereby enclose form PTOL-413A.

B. Continued Examination

Applicants gratefully acknowledge the Examiner's withdrawal of the finality of the previous Office Action and entry of Applicants' submission filed on November 26, 2003.

C. Drawings

Applicants gratefully acknowledge the Examiner's approval of the drawings received on June 6, 2003.

D. Claim Rejections Under 35 U.S.C. § 103

The Office Action rejected claims 3 through 5, 7 through 10, and 12 through 14 under 35 U.S.C. § 103 as being unpatentable over The American Council for an Energy-Efficient Economy (ACEEE) in view of Official Notice regarding obtaining data over the Internet and www.bbbonline.org. The Office Action further rejected claims 2 and 11 under 35 U.S.C. § 103 as being unpatentable over The American Council for an Energy-Efficient Economy

(ACEEE) in view of Official Notice regarding obtaining data over the Internet and www.bbbonline.org and further in view of the "Fuel economy" reference from Consumers Research Magazine. Applicants respectfully traverse each of the 35 U.S.C. § 103 rejections set forth herein in view of the newly added claims and for the reason that Applicants' invention is patentably distinguishable, and not an obvious improvement, over the cited references.

1. No *Prima Facie* Case of Obviousness

In order to establish a prima facie case of obviousness according to MPEP § 706.02(j), the cited references must teach or suggest all of Applicant's claim limitations, and there must be some suggestion or motivation to combine reference teachings with a reasonable expectation of success.

a. Missing Elements

Foremost, it is apparent that the cited references do not teach all of Applicants' claim limitations. Even assuming, *arguendo*, that there is a suggestion or motivation to combine the cited references, there are fundamental differences between the claimed invention and the individual cited references and any combination thereof, such that all of the claim limitations of Applicants' invention are not met by ACEEE, Official Notice, www.bbbonline.org, the "Fuel economy" reference, or any combination thereof.

Applicants' independent claim 15 recites, *inter alia*, a step of developing forecasts of sales of vehicle configurations, and a step of developing environmental performance scores for vehicle models by sales-weighting environmental performance values of environmental data components by the forecasts of sales of the vehicle configurations. Also, Applicants' independent claim 45 recites, *inter alia*, a step of developing forecasts of sales of

configurations, and a step of developing environmental performance scores for models by sales-weighting environmental performance values of environmental data components by the forecasts of sales.

The Applicants respectfully assert that there are significant differences between Applicants' invention and ACEEE, Official Notice, www.bbbonline.org, the "Fuel economy" reference, or any combination thereof. Any combination of the aforementioned references fails to disclose, teach, or suggest the general idea of developing vehicle model environmental data from vehicle configuration environmental data. More significantly, the ACEEE reference, Official Notice, www.bbbonline.org, and the "Fuel economy" references individually and collectively fail to disclose, teach, or suggest anything about sales-weighting any data of any kind by forecasts of sales of vehicle, product, or service configurations to develop vehicle model environmental scores. In fact, the cited references provide no disclosure, teaching, or suggestion of how to develop environmental performance scores at a vehicle, product, or service model level and instead teach reporting of "green scores" merely at a product configuration level. Without such teachings, any combination of the cited references necessarily lacks required and recited elements of the invention: sales-weighting product or service configuration data to enable ranking of products or services to identify top performers of product or service models in product or service utility classes.

Thus, not only do the cited references and any combination thereof not meet all of Applicants' claim limitations, the cited references essentially teach away from Applicants' invention. As stated in the MPEP, if any of the cited references teach away from the suggested combination, or teach away from the claims, or render any of the cited references unsatisfactory for their intended purpose, the claimed invention is distinguishable over the

combination of cited references. (MPEP § 2145) A prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

Moreover, even if the cited references could somehow be combined, any combination to present environmental awards for vehicles at the model level would necessarily result in inferior and misleading results. The ACEEE data are presented only in terms of a vehicle configuration level and are not presented on a vehicle model level. Without the sales-weighting feature of Applicant's invention, any ranking of vehicles at the vehicle model level would not accurately represent, and in fact would blatantly misrepresent, the number of vehicle configurations sold within those models and, thus, would mislead consumers as to the overall environmental performance of a given vehicle model. For example, in any combination of the cited references, low sales volume vehicle configurations would be overrepresented and, conversely, high sales volume vehicle configurations would be underrepresented – thereby yielding unreliable, inaccurate, and otherwise false scores at the vehicle model level. Now, using Applicants' invention, manufacturers, consumers, and the environment may benefit from quantifiable, sales-weighted scoring at the vehicle model level which enables substantiated and truthful marketing of environmental awards at the vehicle model level.

In further support of the traversal of the rejection of the claims under 35 U.S.C. § 103(a) Applicants have enclosed a letter from the United States Environmental Protection Agency as evidence of the nonobviousness of the present invention. (See Exhibit A attached hereto) In the letter, the EPA points out that the methodologies used for rating vehicles by the EPA and Applicants are different but complementary. Note that the ACEEE, like the

EPA, rates vehicles at the vehicle configuration level and not at the model level. The vehicle configuration and vehicle model rating methodologies are complementary because a manufacturer can market an AMES award-winning vehicle at the model level whereby consumers can be informed as to what vehicle models have won awards in the vehicle utility classes that interest them. Thereafter, using the AMES award information at the model level, consumers can consult with a resource such as the EPA or ACEEE to see an environmental rating of a particular vehicle configuration that they are interested in for the given vehicle model that has captured their attention. Therefore, Applicants respectfully assert that the cited references and Applicants' invention cannot, at once, be the same and complementary. By definition, to be complementary the cited references and Applicants' invention must be different – meaning, of course, that important claimed elements of Applicants' invention are missing from the cited references.

Therefore, even if the combination as suggested by the Office Action were legally justified, Applicants' claims would still have novel and unobvious features over the proposed combination. In other words, any attempt at combining the cited references does not disclose all of the claimed features of Applicants' invention and, therefore, the combination would necessarily constitute a different method and different result than the claimed invention.

b. No Basis to Modify or Combine the Cited References

One of ordinary skill in the art would have no basis for modifying or combining the teachings of the ACEEE reference, Official Notice, www.bbbonline.org, and the "Fuel economy" reference in order to attempt to replicate Applicants' invention, because there is no suggestion or motivation in the art to do so. It is well settled patent law that a sustainable obviousness rejection requires "some teaching, suggestion, or motivation to

combine the references,” as summarized by *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998).)

The cited references themselves contain no suggestion whatsoever for combining the references to teach the invention as claimed according to Applicants’ disclosure. In other words, there is nothing in the references alone or together that suggest the claimed invention as a solution to the problem of environmental performance rating systems, which are not compatible with industry or consumer needs and, in fact, Applicants’ had to invent a solution to that problem.

In contrast, the solutions taught by the cited references are directed to problems totally different than that identified in Applicants’ invention. For example, the ACEEE reference is directed to the problems associated with automakers’ environmental performance claims that are based on laboratory tests that poorly relate to typical driving conditions. The ACEEE reference teaches development of “green scores” on a vehicle configuration level that account for the discrepancy between lab tests and real-world driving. In fact, Applicants’ teachings are directed to a problem not even recognized in the cited references when considering all the cited references singularly or collectively.

Not a single applied reference mentions the potential problem of environmental performance rating systems being incompatible with consumer or industry needs. The existing environmental rating systems merely inform a consumer about vehicle configuration performance, such as by engine, transmission, body style, fuel type, emission standard, and city and highway fuel economy categories. Unfortunately, however, such a rating system requires consumers to fumble through an automobile dealer’s lot searching for a desired vehicle configuration verifiable only by the U.S. government “Vehicle

Certification Configuration” that is identified on an emissions compliance label located under the hood in order to find the vehicle that he is looking for. Absent a recognition of this problem, it would be impossible for its solution to be obvious to anyone, and the cited references cannot possibly suggest, singularly or in combination, a solution as novel as Applicants’ invention.

In view of a lack of a motivation to combine the references, a person of ordinary skill in the art would not seek to combine these references cited in the Office Action to produce the results that Applicants’ invention teaches. It is only through Applicants’ own teachings and disclosure that one of ordinary skill in the art would appreciate the need for a step of developing forecasts of sales of product or sales configurations, and a step of developing environmental performance scores for product or sales models by sales-weighting environmental performance values of environmental data components by the forecasts of sales in order to solve the deficiencies in the environmental performance reporting of the prior art. In other words, but for Applicants’ disclosure, there is no teaching, suggestion, or motivation whatsoever to combine the ACEEE reference, Official Notice, www.bbbonline.org, and the “Fuel economy” reference in any way in order to obviate Applicants’ invention as specifically claimed by Applicants.

Applicants’ invention is thus an unobvious improvement over the cited references and not an obvious modification or combination of any of the references of record in this application. When viewed singularly or collectively, none of the cited references discloses, teaches, or even suggests a step of developing forecasts of sales of product or service configurations, and a step of developing environmental performance scores for product or service models by sales-weighting environmental performance values of environmental data

components by the forecasts of sales and, in fact, Applicants' method performs this for the first time. Thus, independent claims 15 and 45 are not rendered obvious by any of the cited references. Under principles of claim dependency and for at least the reasons stated above, the cited references do not render obvious any of the dependent claims either.

Accordingly, it is respectfully submitted that in view of a lack of true motivation in the art to combine the cited references, the subject matter of claims 15-57 would not have been obvious to one of only ordinary skill in this art from the teachings of ACEEE or the other cited references. This is especially true in view of the admonition of the Federal Circuit to avoid "hindsight" in the application of prior art references to claims of an application, as set forth in *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992), where the court stated "[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *Id.* at 1784.

E. Supplemental Information Disclosure Statement

Applicants hereby supplement their original information disclosure statement with the enclosed PTO/SB/08B Information Disclosure Statement form, which discloses the "Green Guide to Cars & Trucks" for the model year 1998, which is believed to have been published as early as the middle of the 1998 model year, perhaps in March of 1998.

F. Supplemental Powers of Attorney

Applicants hereby supplement their original powers of attorney with the enclosed and executed PTO/SB/81 forms.

Appl. No. 09/653,555
July 6, 2004
Reply to Office Action of April 6, 2004

PATENT

III. CONCLUSION

In view of the foregoing remarks, the Applicants respectfully submit that the pending independent and dependent claims are in proper form, define patentably over the cited references, and are all allowable. Applicants, therefore, respectfully request that a formal and timely Notice of Allowance of the application be issued.

If the Examiner has any questions with respect to any matter now of record, the Applicants' attorney may be reached at the telephone number below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 50-0852.

Respectfully submitted,

REISING, ETHINGTON,
BARNES, KISSELLE, P.C.

Date: _____

7/6/04

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Certificate under 37 CFR §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service Express Mail No. EV 395901779US in an envelope addressed to: Mail Stop Amendment, Honorable Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 6, 2004.

Date: July 6, 2004



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